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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHRISTMAN, KATHLEEN M

ART UNIT PAPER NUMBER

3713

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/806,983	<b>Applicant(s)</b> BAJER ET AL.	
	<b>Examiner</b> Kathleen M Christman	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/30/2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-37 is/are allowed.
- 6) ☒ Claim(s) 1-24 and 38-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

In response to the preliminary amendment filed 03/23/2004, claims 1-55 are pending.

#### ***Priority***

Applicant is requested to update the status of the application(s) relied upon for priority in the first line of the specification.

#### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 11/30/2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent No. 6,736,642 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

2. Claims 18-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 18-24, for a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The claimed method does not apply, involve, use, or advance the technological arts. The recited steps of merely presenting information to a user, obtaining reactions (responses) from the user, recording the reactions

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and presenting more information (a second portion of the stimulus, feedback) to the user does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to train a user to identify an assumption. Although the preamble recites "computer implemented" the mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3, 6, 8-11, 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Kerwin (US 5616033).** Regarding **claims 1, 9 and 17**, Kerwin teaches an educational system, method and computer based media in which the user is presented a stimuli in a simulation, is prompted to enter a response to the stimuli, the prompt being automatic (**claims 3 and 11**), (answering a multiple choose question), receives the response, allows the user to enter an assumption that forms that basis for the response and ways to validate the assumption (the user enters a narrative response), receives the information, and produces feedback to the user. Regarding **claims 2 and 10**, the simulation in Kerwin is typically displayed as a text simulation. The use of a multiple-choice question demonstrates the user selecting a response from a listing of a plurality of responses, as in **claims 6 and 14**. In regard to **claims 8 and 16**, as there is no limit to the number of assumption, or sentences that the Kerwin narrative

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response can include the feedback produced from this is based upon the number of assumptions entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 4, 5, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin (US 5616033) in view of Sallette (US 6155840).** Kerwin does not explicitly teach the use of a transcript (claims 4 and 12) or the display of the assumption and how to validate the assumptions being displayed(claims 5 and 13). Sallette teaches computer based training system in which there is a window for displaying presentation text and transcripts of the training system, see Figure 7 and presentation and notes section shown in Figure 6. As both inventions are drawn to computer based education systems it would have been obvious to one of ordinary skill in the art to combine the teachings of Kerwin with those of Sallette in order to allow a user to review the information from earlier in the session.

5. **Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerwin in view of Ramshaw et al (US 5791907).** The Kerwin patent does not explicitly show that ability for a user

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to access a knowledge database. Ramshaw et al teaches the ability for a user to access a database of information in Figure 3A. As both inventions are drawn to computer based educational systems it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the educational system of Kerwin with the databases as taught by Ramshaw et al so as to allow a user to further investigate a topic.

6. **Claims 38-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sallette (US 6155840) in view of Mortimer et al (US 6091930).** Sallette discloses an apparatus, method of use, and computer readable medium storing instruction for an interface for a computer teaching system. Regarding **claims 38, 44, and 50** of the instant application and referring to figure 6 of Sallette, there is a navigation bar, a frame for displaying a video presentation, a text box for displaying questions relating to the presentation, and a second frame containing a transcript of the presentation possibly including those questions asked and their respective answers. Regarding **claims 39, 45, and 51**, the presentation is shown in this embodiment as a video presentation. Regarding **claims 40, 46, and 52**, it is an old and well-known property of a transcript that any action that is taken is recorded in it, therefore having the questions and their answers present and enumerated is also old and well-known. Regarding **claims 41, 47 and 53** two pages overlaid to "form a folder" are shown in 615. Additionally please see figure 7, col. 2 lines 29-31, 35-50, 65- col. 3 line 23, col. 6 lines 21-25, col. 8 lines 48-52, 62- col. 9 line 4 and col. 9 lines 28-37, 40-44, 51-55.

Sallette does not specifically teach "a second text box for illustrating comments entered by the user during the training session, and for displaying assumptions and information on how to validate the assumptions", as in **claims 38, 44, and 50**, or a link to a reference page, as in **claims 42, 48, and 54**.

Mortimer teaches a customizable interactive textbook used for the presentation of material in an educational environment. This includes a notes module, which is described in col. 17: 46+ with particular attention to col. 18: 25-29. The use of the notes section including assumptions and information on how to validate the assumptions is equated to col. 18: 43-59. In col. 19: 29-40 a link system is described. This system equates to the reference pages.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Sallette system with the notes module and reference links of Mortimer et al so as to allow a student to write memory jogging notes or look up background information on a topic.

Neither Sallette nor Mortimer specifically teaches the use of a "pop-up" window to enter comments, as in claims **43, 49, and 55**. It is the examiner's position that pop-up windows are an old and well-known method of entering information into a system.

#### ***Allowable Subject Matter***

7. Claims 25-37 are allowed.

#### ***Response to Arguments***

##### Withdrawn Rejections

The following rejections have been withdrawn in view the amendments made to the claims:

Rejection of claims 17 and 32-43 under 35 USC §101

Rejection of claims 1-17 and 25-31 under 35 USC §112, second paragraph

The rejection of claims 1 and 9 under the judicially created doctrine of obvious type double patenting has been withdrawn in view of the Terminal disclaimer filed.

##### Maintained Rejections under 35 USC §101

The rejection of claims 18-24 under 35 USC §101 is maintained.

Applicant states on page 13 of the response "In order for a computer-related process to be statutory subject matter, 'the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts.'" This citation is taken from MPEP §2106. The examiner agrees with the applicant's assertion. However, the examiner rejection asserts that applicant's invention, as presently claimed, does not fall within the technological arts. Applicant has not argued this assertion, nor has the applicant shown how the amendments to the claims overcome this rejection.

##### Maintained Rejections under 35 USC §102(e)

The rejection of claims 1-3, 6, 8-11, 14, 16 and 17 as being anticipated by Kerwin is maintained.

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The applicant argues that Kerwin fails to teach the limitation of "allowing the user to enter assumptions that form a basis of the responses" and "outputting feedback based on the stimuli and responses, wherein the feedback relates to appropriate assumptions and information of how to validate the appropriate assumptions and is associated with prompting the user of a necessity to validate the assumptions". The applicant contends that although applicant may allow a user to enter a narrative it is not suggested any further interaction with the trainee utilizing the entered narrative. This argument is not commensurate with the scope of the currently pending claim. The feedback of applicant's claim as currently presented is drawn does not take the assumptions entered into the system into consideration. The feedback is based only on the stimuli and the responses, not the assumptions that are entered by the user.

Maintained Rejections under 35 USC §103(a)

The rejections of claims 4, 5, 12 and 13 as being obvious over Kerwin in view of Sallette and the rejection of claims 7 and 15 as being obvious over Kerwin in view of Ramshaw are maintained.

The applicant argues that these claims are patentable for the same reasons as those asserted for claims 1 and 9. The rejections are maintained for the reason's given above with regard to the rejections under 35 USC §102(e).

The rejection of claims 38-55 as being unpatentable over Sallette in view of Mortimer et al is maintained

The applicant argues generally that the relied upon sections of Mortimer fail to teach "displaying assumptions and information on how to validate the assumptions, wherein the assumptions for a basis of the answers", as recited in amended claims 38, 44 and 50. Applicant further asserts that Mortimer can not suggest generating answers because there is no communication path from the student to the professor. It is unclear how the applicant believes this feature, whether present or absent from Mortimer, overcomes the current rejection of the claims. The applicant's currently claimed invention is not directed to the communication abilities of the interface. The arguments do not appear to be commensurate with the cope of the claims.



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**Conclusion**


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (571) 272-4435. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kathleen M. Christman  
February 17, 2005

  
**JOHN M. HOTALING, II**  
**PRIMARY EXAMINER**